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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,653	03/12/2001	Winfried Siffert	741135-12	6614
22204	7590	10/22/2004	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			MYERS, CARLA J	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/803,653

Applicant(s)

SIFFERT, WINFRIED

Examiner

Carla Myers

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 18-27 and 41-50.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
CARLA J. MYERS  
PRIMARY EXAMINER

Continuation of 2. NOTE: The amendment to claims 18, 20-24, 41 and 43-47 raise new issues under 35 U.S.C. 112, first paragraph (new matter). While the specification as originally filed provides support for the concept that the presence of the 825T allele is associated with reduced responsiveness to insulin, hormones, transmitters, neurotransmitters and pharmaceuticals which activate G protein heterodimers containing the G protein subunits Gbeta3 and Gbeta3s (see pages 12 and 34), the specification does not provide support for the concept that the 825T allele is associated with reduced responsiveness to all in vivo pharmaceuticals or that the 1429T allele is associated with reduced responsiveness. The amendments to claims 48 and 49 raise new issues under 35 U.S.C. 112 second paragraph because the phrases "the presence of thymidine at position 825" lacks proper antecedent basis since the claims previously refer to a thymine at position 1429. Also, if claim 27 becomes allowable, claim 50 would be objected to as being a substantial duplicate of claim 27. It appears that claim 50 intends to refer back to claim 49, rather than claim 26.

Continuation of 5. does NOT place the application in condition for allowance for the reasons of record in view of the non-entry of the after final amendment. Further, the rejections under 35 U.S.C. 102a over Naber and over Zill are each maintained because Applicants have not established priority to the filing date of September 6, 1999. In the response of 10/5/04, Applicants state that certified copies of the priority documents have been filed, together with translations of the priority documents. However, a translation of priority document PCT/EP99/06543 has not been filed. Accordingly, Applicants have been given the filing date of the present application, i.e., March 12, 2001. Thereby, Naber and Zill are each prior art to the claimed invention. With respect to the rejection under 35 U.S.C. 112, first paragraph (enablement), it is noted that the specification has enabled the subject matter of un-entered claims 19 and 25-27. With respect to claims 18 and 20-24, the previous 112, first paragraph rejection would be overcome by further amendment of these claims to clarify that the in vivo pharmaceutical is one which activates G protein heterodimers containing a G protein subunit Gbeta3 or Gbeta3s. The 112 first rejection is maintained over claims reciting the detection of the 1429 polymorphisms for the reasons set forth in the previous office action. In response to this rejection, Applicants do not specifically address the 1429 polymorphism, but rather state in general that pages 11-35 of the specification teach methods for predicting diseases including diabetes mellitus, adiposity/obesity, coronary heart disease etc. However, the claims are not drawn to methods for diagnosing these diseases. Rather, the claims are drawn to methods for predicting a patient's response to an in vivo pharmaceutical. As discussed in the final rejection, the specification has not established that the 1429 C or T allele is associated with either an increased or decreased responsiveness to any particular pharmaceutical.